

REMARKS

This paper is a Response to the Office Action mailed November 22, 2010 issued in connection with the above-identified application. By this Response, claims 19 and 21 have been cancelled without prejudice. Applicants maintain the right to prosecute the cancelled claims in any related application claiming the benefit of priority of the subject application. Accordingly, claims 1 (in part), 17 and 18 are under consideration.

Regarding the Claim Amendments

Claims 17 and 20 have been amended to define the subject matter with greater particularity. The amendments are supported by originally filed claims 17 and 20. Accordingly, the amendments do not add new matter and entry thereof is respectfully requested.

Rejections under 35 U.S.C. §102

The rejection of claims 1, 17 to 19 and 21 under 35 U.S.C. §102(b) as allegedly anticipated by Choi *et al.* (US Pub. No. 2002/0086067) is respectfully traversed. The grounds for rejection are set forth in the Office Action at page 3.

Claims 1, 17 to 19 and 21 are not anticipated by Choi *et al.* Nevertheless, solely in order to further prosecution of the application, claims 19 and 21 have been cancelled herein without prejudice, and the claims have been amended. Applicants will therefore address the rejection as if applied to the amended claims.

Anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration *In re Spada*, 911 F.2d 705 (Fed. Cir. 1990), *In re Bond*, 910 F.2d 831 (Fed. Cir. 1990). A reference cited under 35 U.S.C. §102 must contain “an enabling disclosure.” *In re Hoeksema*, 399 F.2d 269 (C.C.P.A. 1968).

Amended claims 17, 18 and 20 are directed to treatment or diagnosis of a polyglutamine disease. In contrast, Choi *et al.* fail to teach or suggest treatment or diagnosis of a polyglutamine disease, let alone by administering a compound of claim 1. Accordingly, as Choi *et al.* fail to teach each and every element of claims 17, 18 and 20, the rejection under 35 U.S.C. §102(b) must be withdrawn.

The rejection of claims 1, 17 to 19 and 21 under 35 U.S.C. §102(b) as allegedly anticipated by Castillo *et al.* (WO 03/013442) is respectfully traversed. The grounds for rejection are set forth in the Office Action at pages 3-4.

Claims 1, 17 to 19 and 21 are not anticipated by Castillo *et al.* Nevertheless, solely in order to further prosecution of the application, claims 19 and 21 have been cancelled herein without prejudice, and the claims have been amended. Applicants will therefore address the rejection as if applied to the amended claims.

Amended claims 17, 18 and 20 are directed to treatment or diagnosis of a polyglutamine disease. In contrast, Castillo *et al.* fail to teach or suggest treatment or diagnosis of a polyglutamine disease, let alone by administering a compound of claim 1. Accordingly, as Castillo *et al.* fail to teach each and every element of claims 17, 18 and 20, the rejection under 35 U.S.C. §102(b) must be withdrawn.

CONCLUSION


In summary, for the reasons set forth herein, Applicants maintain that the claims clearly and patentably define the invention, respectfully request that the Examiner reconsider the various grounds set forth in the Office Action, and respectfully request the allowance of the claims which are now pending.

If the Examiner would like to discuss any of the issues raised in the Office Action, Applicant's representative can be reached at (858) 509-4065.

Please charge any fees associated with the submission of this paper to Deposit Account Number 033975, Order No. 051501-0376926. The Commissioner for Patents is also authorized to credit any over payments to the above-referenced Deposit Account.

Respectfully submitted,

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